

REMARKS/ ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Specification Objections

The Examiner objected to the title of the specification as not being descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title has been amended per the Examiner's suggestion.

Drawing Objections

The Examiner objected to the drawings for failing to comply with 37 C.F.R. § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 3b, 3c, 19a, 19b, 21a, and 21b, in Figure 1; 12a and 12f in Figure 2.

Applicants have amended Figures 1 and 2 and removed the reference signs.

No new matter has been added.

For the Examiner's convenience, a complete set of Drawings, including Replacement Sheets for Figures 1 and 2 are being submitted herewith in compliance with 37 C.F.R. § 1.84(p)(5). No new matter has been added.

35 U.S.C. § 103(a) Rejections

Examiner rejected independent claims 1 and 6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,933,594 (hereinafter "La Joie") in view of U.S. Patent 6,072,804 (hereinafter "Beyers").

Examiner also rejected independent claims 10 and 14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,933,594 (hereinafter "La Joie") and U.S. Patent 6,072,804 (hereinafter "Beyers") as applied to Claim 1 above and further in view of U.S. Patent 5,961,578 ("hereinafter "Nakada").

To establish a *prima facie* case of obviousness, certain criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. (MPEP 2143).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

In the present matter, neither La Joie nor Beyers suggest nor motivate combining the disclosure of La Joie and Beyers to provide a buffer, in a component coupled to a bus, to observe and echo signals transmitted on the bus. In particular, Beyers is concerned with "interconnecting consumer electronic equipment." (Beyers col. 1, lines 5). There is no suggestion in Beyers to combine a buffer disclosed Beyers with a bus logic analyzer of La Joie.

Moreover, one skilled in the art at the time of Beyers and La Joie, would not have considered combining the two references considering the distinct fields

that each respectively addresses. In particular, Beyers being concerned with a data transfer system useful for interconnecting consumer electronic equipment, and La Joie being concerned with diagnosis of computer errors.

In addition, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time claimed invention was made" because the references relied upon teach that all aspect of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine or modify the teachings of the reference. *Ex Parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). (MPEP 2143.01).

In the present matter, there is no objective reason to combine disclosure of La Joie and Beyers to provide a buffer, in a component coupled to a bus, to observe and echo signals transmitted on the bus. This is especially true, when taking into account the two references address distinct fields, including Beyers relating to a data transfer system useful for interconnecting consumer electronic equipment, and La Joie relating to diagnosis of computer errors.

Furthermore, Applicants respectfully submit that it would not have been obvious to combine disclosure of La Joie and Beyers to provide a buffer, in a component coupled to a bus, to observe and echo signals transmitted on the bus, because there would have been no reasonable expectation of successfully combining La Joie and Beyers at the time La Joie and Beyers were invented. (See Manual of Patent Examining Procedure ¶ 2143.02; See also *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), and *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

Therefore, no suggestion or motivation is found in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to combine reference teachings. Moreover, there is no reasonable expectation of successfully combining the references. As a result, applicant's independent claims are patentable over La Joie, Beyers, and Nakada.

In addition, the remaining claims depend from one of the independent claims as discussed above, and therefore include similar limitations, and as a result are patentable over the references La Joie, Beyers, and Nakada.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

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Date: 10/31/03

  
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Appl. No. 09/752,880  
Amdt. dated \_\_\_\_\_  
Reply to Office action of July 30, 2003